

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte VIKTORS BERSTIS

Appeal No. 2006-1818
Application No. 09/466,438
Technology Center 3600

ON BRIEF

Before OWENS, CRAWFORD, and BAHR, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

The examiner has finally rejected claims 1 to 6, 8 to 10, 13 to 23 and 25, which are all of the claims pending in this application. Claims 7, 11, 12 and 24 have been cancelled.

The appellant's invention relates to a system and method for automatically authorizing a remote point of purchase action at a facility which permits such action. The system prompts a user with additional security-related questions when the user selects responses that deviate from the user's typical selections (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Penzias	5,311,594	May 10, 1994
Kanevsky et al. (Kanevsky)	5,774,525	Jun. 30, 1998
Findley	6,108,642	Aug. 22, 2000
		(Filed Feb. 02, 1998)

The rejections

Claims 1 to 4, 6, 8, 9, 13 to 21, 23 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Findley in view of Kanevsky.

Claims 5, 10 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Findley in view of Kanevsky and Penzias.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed March 9, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed December 15, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner.

Appellant's invention is a method for automatically authorizing a remote point of purchase action at a facility including the initial step of storing selections of goods and services made by an authorized user during a previous transaction into a user profile (specification at page 9). This user profile in a fuel pump environment includes the type of fuel usually purchased by the user, whether or not the user usually requests a receipt, whether the user purchases a car wash and the type of car wash (specification at page 10). After the user profile is retrieved, the method compares whether the current purchase matches the user profile

(specification at page 10). If there is an inconsistency between the user profile and the current purchase, the user is required to answer a security question.

The examiner relies on Findley for disclosing the invention as claimed except that the examiner recognizes that the Findley system does not require the user to answer a security question. The examiner relies on Kanevsky for this teaching. The examiner also recognizes that Findley does not describe requiring the user to answer this question if the current purchase is inconsistent with the user profile. The examiner states:

. . . Examiner takes Official Notice that a plurality [of] conditions are old and well known as criteria for making determinations of fraud. These include but are not limited to the two embodiments of Findley (i.e. current merchant versus past merchant, and quantity of items purchased) as well as a comparison between a current item purchased versus past items purchased [answer at page 6].

In our view, the examiner has improperly utilized the concept of Official Notice to supply a critical limitation of appellant's claimed invention that is missing in the prior art relied upon by the examiner. As set forth in In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970): the Patent Office ... may take notice of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute. In re Knapp Monarch

Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961). This rule must be construed narrowly and must regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Allegations concerning specific "knowledge" of the prior art, which might be peculiar to a particular art should be supported and the appellant given the opportunity to make a challenge. See In re Spormann, 363 F.2d 444, 448, 150 USPQ 449, 452 (1966).

Typically, it is found necessary to take notice of facts which may be used to supplement or clarify the teaching of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching. The facts so noticed serve to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. Facts judicially noticed should not comprise the principal evidence upon which a rejection was based.

While a person of ordinary skill in the art may possess the requisite knowledge and ability to modify the method of Findley, the modification is not obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d

900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there are some teachings, suggestions, or motivations to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In view of the foregoing, we will not sustain the examiner's rejection of claim 1 and claims 2 to 4, 6, and 8 dependent thereon. We will also not sustain this rejection as to claims 9, 14 and 18 and claims 13, 15 to 17, 19 to 21, 23 and 25 which depend therefrom because each of claims 9, 14 and 18 require that a user be asked a security question if the options goods and/or services by the user is inconsistent with the user profile. We will likewise not sustain the rejection of claims 5, 10 and 22 which are dependent from claims 1, 9 and 18 respectively under 35 U.S.C. § 103 as being unpatentable over Findley, Kanevsky and Penzias because the examiner relies on Official Notice in this rejection for the limitation of asking a security question if the option for goods and/or services by the user is inconsistent with the user profile.

REMAND

This case is remanded to the examiner to determine whether prior art is available that would have fairly suggested to one of ordinary skill in the art to modify the Findley method to include the step of requiring the user to answer a security-related question if the options for goods and/or services by the user are inconsistent with the user's prestored selections of goods and/or services.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection.

REVERSED/REMANDED

TERRY J. OWENS

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~~MURRIEL E. CRAWFORD~~

Administrative Patent Judge

JENNIFER D. BAHR

Administrative Patent Judge

MEC/vsh

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